

REASONS IN SUPPORT OF PRE-APPEAL
BRIEF REQUEST FOR REVIEW**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Jeffry Jovan Philyaw; David Kent Mathews

Serial No.: 09/494,924

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Group: 2167

Examiner: J. Fischetti

For: INPUT DEVICE FOR ALLOWING INTERFACE TO A WEB SITE IN
ASSOCIATION WITH A UNIQUE INPUT CODECommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**REASONS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Please consider the following reasons in support of the concurrently filed Pre-Appeal Brief Request for Review.

In the final rejection mailed on May 18, 2006, claims 22-27 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of the combination of *Hudetz et al.*, *Ogasawara*, and *Simonoff et al.* It is respectfully submitted that these §103 rejections are clearly not proper and are without basis. More specifically, as discussed below, the §103 rejections have a clear legal deficiency, because there is no motivation, teaching or suggestion to combine the references and because not all claim limitations are taught as needed to establish a *prima facie* rejection.

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In more detail, MPEP §2142 specifies that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In regard to what an examiner must show in order to establish a *prima facie* case of obviousness, MPEP §2142 further explains that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In regard to what an examiner must do in order to meet the first criterion for a *prima facie* rejection, MPEP §2143.01 specifies that:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Federal Circuit recently provided additional guidance on the requirement for establishing a combination by stating that “in making the assessment of differences between the prior art and the claimed subject matter, § 103 specifically requires consideration of the claimed invention ‘as a whole.’ Inventions typically are new combinations of existing principles or features.... The “as a whole”{ instruction in Title 35 prevents evaluation of the invention part by part.... Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. Id. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result—often the essence of invention. Id.”

Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005).

In the present situation, as explained in more detail below, the Examiner proposes various combinations of references without a proper suggestion or motivation to make each proposed

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modification. This means that the first criterion for a *prima facie* rejection has not been met, which in turn means the Examiner has failed to carry the burden of establishing a *prima facie* rejection. In addition, certain claim limitations are not taught or suggested by the cited combinations, which means that the third criterion for a *prima facie* rejection has not been met and that the Examiner has failed to carry the burden of establishing a *prima facie* rejection for this independent reason.

I. No Suggestion or Motivation to Combine the References

A. Applicant submits that there is clear error with respect to the Examiner's rejections of claims 22-27 over the combination of *Hudetz*, *Ogasawara* and *Simonoff* et al. As detailed at length on pages 4-23 of Applicant's response (filed on November 20, 2006 in response to the final office action dated May 18, 2006), the rejections of claims 22-27 are deficient because there is no motivation to combine these references. In fact, as detailed in the Response, the Examiner's contention is that only a single element of *Ogasawara* is required to show an element in the claim, and the fact that it is this specific element and the existence of it in the prior art that is all that is required for the purpose of showing motivation.

For example, as detailed in paragraph 11 of the response, *Hudetz* basically sets forth that the purpose of the *Hudetz* system is to provide "a better way for consumers and others to access resources on remote computers, particularly websites" (*Hudetz*, Col. 3, lines 16-18.) In the operation of the invention section of *Hudetz*, beginning at Col. 8, line 21, a detailed process flow is described with respect to the illustration of FIG. 5. Initially, the browser software is programmed to automatically load a "query page" that provides access to a database (*Hudetz*, Col. 8, lines 22-24.) The query page is then transmitted a local host computer in the form of an html document. It is set forth that a UPC code can be entered using either manual entry, voice recognition or other input device (*Hudetz*, Col. 8, lines 36-40.) The UPC code is then transmitted to the web-server resident on a local service provider to look up the entered UPC code in the database, retrieve all records associated therewith that match the product identification number, and then convey these to the user in the form of an html document (*Hudetz*, Col. 8, lines 43-49.)

The Examiner noted on page 2 of the May 18, 2006 Office Action, in the last full paragraph, that *Hudetz* does not provide any disclosure of an input device ID permanently associated with the input device and independent of a first location. The Examiner relies on *Ogasawara* as disclosing such permanently associated ID (i.e., telephone number). In the response filed to the Final Office

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Action, beginning at paragraph 24, Applicant sets forth in detail the arguments as to why *Ogasawara* does not provide an ID that is utilized in such a manner that one skilled in the art would have any desire or any reason to provide an ID in the scanner. First, the telephone number is not utilized for any purpose relating to that associated with *Hudetz*, i.e., *Ogasawara* utilizes the telephone number for the purpose of validating a user in a database for the purpose of associating any kind of transaction with the database, and not for the purpose of combining that telephone number with a scan code for the purpose of providing a match in a database. In fact, the telephone number in *Ogasawara* is not utilized for any matching or looking-up operation wherein information in the database is returned to the user in response to sending a telephone number. The telephone number merely identifies the user such that any transaction that occurs will be recorded the user database. There is no suggestion of use of the ID in *Ogasawara* for the purpose of performing a look-up operation and returning information that is in anyway related to that look-up operation. Thus, the Examiner has failed to show that there is any motivation, teaching or suggestion that would lead one skilled in the art to in any way provide any ID that in any way identifies an input device for the purposes set forth in the claim. Further, Applicant has noted in paragraph 15 of the response that the telephone in *Ogasawara* is a wireless telephone and that the telephone is not uniquely or permanently associated with that telephone – it can be changed merely by obtaining a new telephone and assigning a telephone number to that telephone.

The Examiner has also utilized the *Simonoff* et al. reference and stated that another failure of *Hudetz* is the disclosure of the unique ID associated with the message packet (May 18, 2006 Office Action at page 2, last incomplete paragraph.) The Examiner has stated that this unique ID disclosed at Col. 11, lines 13-68 in *Simonoff* et al. is commonly associated with a message (value) between different locations. As set forth in Applicant's response in paragraph 16, the ID that is disposed with the client device in *Simonoff* is not permanently affixed thereto but, rather, it is assigned thereto. Thus, not only is not permanently a part of the client device when shipped, it can be changed by a client server at a central location. There is no look-up operation and there is no purpose set forth that would provide any motivation or suggestion that the fact that an ID can be downloaded and associated with a particular device for the purpose of future communications would in any way be utilized for the purpose of affixing or permanently disposed ID in the scanning device. In the scanning device of the present claim, the ID is used for a matching operation.

The Examiner has provided the primary reference *Hudetz* and noted deficiencies therein. The

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Examiner has failed to state a *prima facie* case as to combining *Ogasawara* and *Simonoff* and *Hudetz* to cure said deficiencies.

II. Even When Combined, the References Fails Teach or Suggest All Claim Limitations

Applicant has detailed the failure of the references to teach all claim limitations in the previously filed responses. For example, in paragraph 32 of the Response filed on November 20, 2006, Applicant details why the combination of *Ogasawara* and *Hudetz*, in addition to *Simonoff*, fail to teach or suggest the step of “associating the unique input device ID in a message packet, such that the unique input device ID is associated with the message packet for transmission over the network and wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID” as required by independent claim 22.

Conclusion

Applicant submits that not only do the combined references fail to teach or suggest all claim limitations as required, but that the text cited by the Examiner from the various references fails to provide a suggestion or motivation for the various combinations because the text fails to illustrate “why” one skilled in the art would combine the references in the particular manner required. Instead, the text simply identifies particular components for each reference, combines them in a specific manner required by Applicant’s claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Applicant respectfully requests that the rejections under § 103 be withdrawn.

It is respectfully submitted that all the claims in the application are in condition for allowance.

Respectfully submitted,
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